

Atty. Dkt. No.: CC8128-DRIB

Filing Date: 6/29/2000

Serial #: 09/606,721

Examiner: Kidwell, M.

Art Unit: 3761

Kathleen Chapman, chapman1103@prexar.com, 775-218-4407

CONFIDENTIAL

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To: Commissioner for Patents

From: Kathleen Chapman, Esq.

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Date: 3/11/2002

Re: 09/606,721

CC: Mr. Gordon C. Cheng, et al.

Examiner: Michelle Kidwell

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Comments:

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Gordon C. Cheng, James R. Valentine, Richard M. Beane, Daniel M. Beane

For: PERSONAL URINE MANAGEMENT SYSTEM FOR HUMAN MALES

To: The Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Transmitted herewith for filing is the response of Mr. Gordon C. Cheng, Mr. James R. Valentine, Mr. Richard M. Beane, and Mr. Daniel M. Beane to a restriction requirement mailed 2/12/2002.

CERTIFICATE OF FACSIMILE TRANSMISSION (37 CFR § 1.8)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being facsimile transmitted to 703-305-3590 as directed in the Official Action on the date shown to: The United States Patent and Trademark Office, Commissioner for Patents, Washington, D.C. 20231.

Kathleen Chapman
Kathleen Chapman
Reg. No. 46,094

Date: 03/11/2002

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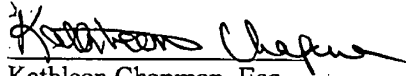
Examiner: Kidwell, M.
Art Unit: 3761

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Enclosed herewith are the following response materials:

1. Election of species under 35 U.S.C. § 121.

Respectfully submitted,



Kathleen Chapman, Esq.

Reg. No. 46,094

DISHONG LAW OFFICES

765 Greenville Rd.

Mason, N.H. 03048

Voice: 603-878-4993; Fax: 603-878-4993

e-mail: chapman1103@prexar.com

3/11/02

Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Cheng, G. et al.

For: PERSONAL URINE MANAGEMENT SYSTEM FOR HUMAN MALES

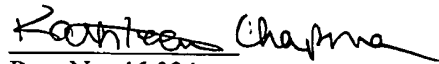
To: The Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Madam/Sir:

CERTIFICATE OF FACSIMILE TRANSMISSION (37 CFR § 1.8(b))

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being facsimile transmitted to 703-305-3590 as directed in the Official Action on the date shown to: The United States Patent and Trademark Office, Commissioner for Patents, Washington, D.C. 20231.

Kathleen Chapman



Date: 03/11/2002

Reg. No. 46,094

RESPONSE TO ELECTION REQUIREMENT UNDER 35 U.S.C. § 121

Election of Group I without Traverse

Responsive to the Requirement for Election/Restriction Office Action dated February 12, 2002, Applicants herewith elect, without traverse, the invention identified as Group I which includes Claims 1-43, 45-68, and 79-94, drawn to a system for collecting, conveying, and storing urine discharged from a male, classified in class 604, subclass 349. Examiner has identified what is perceived to be two invention categories characterized as Groups I - II. Examiner states that Group I, claims 1-43, 45-68, and 79-94, defines the system as above; Group II, claims 44, 69-78, and 95-96, defines the method for pretreating, manufacturing, and using collection tubes.

REMARKS

Examiner has required a restriction of Applicants' invention under 35 U.S.C. § 121. Applicants have provisionally elected without traverse to prosecute the invention defined by the claims of Group I, the claims drawn to a system for collecting, conveying, and storing urine discharged from a human male. Examiner has identified these claims as 1-43, 45-68, and 79-94.

Detailed Remarks:

Examiner has made a requirement for a restriction. Examiner states that the restriction is proper because the two sets of claims, Group I and Group II, are distinct because the system as claimed in the Group I claims can be made by another and materially different process. Applicants acknowledge the requirement for restriction and

elect without traverse to prosecute the invention of Group I, Claims 1-43, 45-68, and 79-94.

Election of Species:

Examiner has additionally required Applicants hereof to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Examiner notes that currently, no claims appear to be generic. Examiner further contends that the application contains claims directed to the following patentably distinct species of the claimed invention: Species 1 as in Fig. 1, readable on claims 1-43, 45-60, 62-68, 73-96. Applicants respectfully point out that Figs. 2A and 2B present the same system as presented in Fig. 1 with additional detail.

Applicants herewith elect to prosecute the species characterized in Fig. 1, Species 1, readable on claims 1-43, 45-60, 62-64, and 73-96. Applicants acknowledge that Examiner's Group I reads on a different set of claims than Applicants have identified as Species 1 claims. Applicants respectfully request prosecution of claims 1-43, 45-60, 62-64, and 73-96. Applicants view claims 73-78 as part of Group I because those claims recite a method of use of the collection system of Fig. 1, in particular the special conduction tube of the illustrative embodiment of the invention. Applicants view claims 95-96 as part of Group I because those claims recite a method of use of the system of Fig. 1, in particular the use of a removable disposable or reusable storage device.

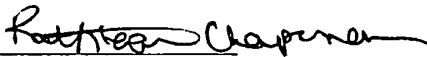
As noted above Applicants have provisionally elected the species of Fig. 1 and have provisionally elected the invention of Group I. Applicants' election is made without prejudice. As noted by the Examiner, upon the allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species in addition to the elected

species, provided that all claims to each additional species are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141.

Claims 1-43, 45-68, and 79-94 are now pending in the application, with claims 73-78 and 95-96 under consideration as part of Group I and possibly also pending. The remaining claims, 44 and 69-72 have been withdrawn from consideration.

Applicants submit that this election is responsive to Examiner's requirement for election of species. An action on the merits of all of the claims and a Notice of Allowance thereof are respectfully requested. The fees associated with this response, if there are any due, are included herewith. Applicants respectfully request that Examiner contact their attorney by telephone or by facsimile if there are any additional questions relative to this patent application.

Respectfully submitted,



Kathleen Chapman, Attorney for Applicant

Reg. No. 46,094

DISHONG LAW OFFICES

765 Greenville Rd.

Mason, New Hampshire 03048

Tel # 603-878-4993; Fax # 775-218-4407